

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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Washington, D.C. 20231

SERIAL NUMBER	REQUEST DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/743,644	4/21/04	RODRIGUEZ	0110-0001

Title: **CORDLESS TELEPHONE-TO-SOUND CARD
INTERFACE ADAPTER HAVING A HYBRID
TRANSFORMER CIRCUIT**

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Art Unit	Paper Number
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Correspondence Address:

JOHN J. OSKOREP
ONE MAGNIFICENT MILE CENTER
SUITE 1400
980 N. MICHIGAN AVENUE
CHICAGO, IL. 60611

PATENT & TRADEMARK OFFICE
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SEP 02 2004

LICENSING & REVIEW

Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 533,155
Grant Date: 02-Sep-04

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for Commissioner of Patents and Trademarks

This license empowers the filing, the causation and the authorization of the filing of a foreign application or applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such application or applications.

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LICENSE FOR FOREIGN FILING

[Title 35, United States Code (1952) Sections 184, 185, 186]

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
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WASHINGTON, DC 20231
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John J. Oskorep, Esq.
One Magnificent Mile Center
980 N. Michigan Avenue, Suite 1400
Chicago, Illinois 60611

In re: Rodriguez. : DECISION ON REQUEST
Serial No.: 10/743,644 : UNDER 37 CFR 5.25
Filing date: December 22, 2003
Docket No: 0110-0001

**Title: CORDLESS TELEPHONE-TO-SOUND CARD INTERFACE ADAPTER
HAVING A HYBRID TRANSFORMER CIRCUIT**

This is a decision on the petition filed on August 2, 2004 for retroactive foreign filing license.

It has been determined that a retroactive license for foreign filing under 35 U.S.C.184 be granted with respect to the filings listed below. The petition complies with 37 C.F.R. 5.25 in that there is an adequate showing that the subject matter in question was not under a secrecy order, that the license was diligently sought after discovery of the proscribed foreign filing, and that the material was filed abroad without the required license under 37 C.F.R 5.11 through error and without deceptive intent.

Country

Date

Mexico

July 2, 2003

Ian J. Lobo
Patent Examiner
(703) 306-4161



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

RODRIGUEZ

Serial No.: 10/743,644

Filing Date: 12/22/2003

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)
)

Group No.: N/A

Examiner: N/A

Docket No.: 0110-0001

Entitled:

**"CORDLESS TELEPHONE-TO-SOUND CARD INTERFACE ADAPTER
HAVING A HYBRID TRANSFORMER CIRCUIT"**

RECEIVED

AUG 5 2004

LICENSING & REVIEW

MAIL STOP PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**RESPONSE TO COMMUNICATION REGARDING PETITION
FOR RETROACTIVE LICENSE UNDER 37 CFR SECT. 5.25**

The Applicant respectfully submits this paper in response to the Communication from the USPTO mailed on 24 May 2004 regarding the Petition For Retroactive License Under 37 CFR Sect. 5.25 filed on 21 April 2004 for the above-referenced patent application.

**RESPONSE TO COMMUNICATION REGARDING PETITION
FOR RETROACTIVE LICENSE UNDER 37 CFR SECT. 5.25**

The Applicant submits this paper in response to the Communication from the USPTO mailed on 24 May 2004 regarding the Petition For Retroactive License Under 37 CFR Sect. 5.25 for U.S. patent application entitled "CORDLESS TELEPHONE-TO-SOUND CARD INTERFACE ADAPTER HAVING A HYBRID TRANSFORMER CIRCUIT" (Inventor Luis Ricardo Rodriguez) having U.S. Serial No. 10/743,644 and a filing date of December 22, 2003.

In the Communication, it was indicated that the Petition was denied as not meeting the requirements of 37 CFR 5.25 (1) (2) and (3)(ii-iii).

In response, the Applicant respectfully requests reconsideration of the Petition. The requirements for a retroactive license have indeed been met and further support is provided herewith. Upon reconsideration, the Applicant respectfully submits that the Petition should be granted for the following reasons.

As indicated in the communication, 37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed;
2. The dates on which the material was filed in each country;
3. A verified statement (oath or declaration) containing:
 - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order;
 - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing;
 - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under Sect. 5.11 first having been obtained; and
4. The required fee (Sect. 1.17(h)).

The Communication indicated that the petition was denied due to the following specific objections: (1) a listing of each foreign country and associated filing dates was not included; (2) a copy of the application in English was not included; and (3) the evidence provided to conclude that the material was filed abroad through error and without deceptive intent was insufficient.

Response to Objection (1). In response to (1) above, the Applicant respectfully submits that the Petition did indeed provide a listing of each of the foreign countries in which the unlicensed patent application was filed and the dates on which the material was filed in each country. That listing was provided in the Petition on page 2, paragraph 2. It is a possibility that this information was overlooked. There is only one foreign country for which a patent filing was made: Mexico. The Applicant provides this information again below in a more formal manner:

<u>Country</u>	<u>Application No.</u>	<u>Application Title</u>	<u>Filing Date</u>
Mexico	PA/a/2003/005992	Device Allowing Connection of Wireless Telephone to Computer for Internet Telephony	2 July 2003

Thus, objection (1) should now be overcome.

Response to Objection (2). In response to (2) above, the Applicant respectfully submits that a copy of the patent application in English was indeed provided with the Petition. It is a possibility that the material was also overlooked or lost. In any case, the Applicant again submits copies of the Mexican patent application herewith in both Spanish and English (translation of the Mexican patent application). Thus, objection (2) should now be overcome.

Response to Objection (3). In objection (3) above, it was indicated specifically in the Communication that the Petition “fails in that it lacks sufficient evidence to conclude that the material was filed abroad through error and without deceptive intent. Sufficient evidence would include a verified statement or statements by the person or persons (in the instant case British [sic] counsel) who had knowledge and made the actual decision to file. Such a statement should reference the error of not obtaining a foreign license. Statements of error must be supported by fact. They should not be merely conclusionary but must include how and why the error occurred.”

In response to objection (3) above, the Applicant had indeed submitted a verified statement by the inventor Mr. Rodriguez who had knowledge and played a part in the actual decision to file. See e.g. page 1 at lines 12-14 of the Declaration of Luis Ricardo Rodriguez. This Declaration does indeed reference the error of not obtaining the foreign license. See e.g. page 1 at lines 12-14, page 2 at lines 6-8, and page 3 at lines 4-5. This Declaration is also supported by fact and includes how and why the error occurred. See e.g. page 2 at lines 8-20, and page 3 at lines 4-5. In addition, the Applicant had also submitted a Declaration from Mr. Rodriguez’s patent attorney, John J. Oskorep, the undersigned, who confirms Mr. Rodriguez’s actions and intent. The Applicant submits copies of these Declarations again in the event they were misplaced or overlooked.

In addition, the Applicant submits herewith an additional Declaration of Mr. Arturo Bustamante. Mr. Bustamante was the Mexican agent who prepared and filed the Mexican patent application for Mr. Rodriguez. Along with Mr. Rodriguez, Mr. Bustamante filed the subject matter abroad through error and without deceptive intent. Reviewing his Declaration, Mr. Bustamante had direct knowledge and played a part in the actual decision to file. See e.g. page 1 at lines 2-5. This statement does indeed reference the error of not obtaining the foreign license. See e.g. page 1 at lines 10-19 through page 2 at lines 1-3, as well as page 2 at lines 6-7. Mr. Bustamante’s statement is also indeed supported by fact and includes how and why the error occurred. See e.g.

page 1 at lines 8-13, page 1 at lines 15-19, page 2 at lines 2-5, and page 2 at lines 6-7.
Thus, objection (3) should now be overcome.

Final Comments. The Applicant again respectfully requests reconsideration of the Petition. All requirements have been met and further support is provided herewith. The specific concerns regarding (1), (2), and (3) above have been overcome. For the reasons provided herein, the Applicant respectfully requests that the Petition be granted.

Note that we continue to be diligent in the pursuit of the retroactive license. I personally became aware of this issue during the week of March 22 – 26th 2004 and I diligently took steps during the subsequent weeks to produce and file the initial Petition. I continue with my diligence by filing this Response within the specified timeframe in the Communication.

Thank you. Please feel free to contact the undersigned for any reason if it would expedite the handling of this matter.

Date:

29 June 2004

JOHN J. OSKOREP, ESQ.
ONE MAGNIFICENT MILE CENTER
980 N. MICHIGAN AVENUE, SUITE 1400
CHICAGO, ILLINOIS 60611

Telephone: (312) 222-1860

Fax:

(312) 214-6303

Attachments:

- (1) Copy of Mexican patent application;
- (2) Copy of English translation of Mexican patent application;
- (3) Copy of Declaration of Luis Ricardo Rodriguez;
- (4) Copy of Declaration of John J. Oskorep; and
- (5) Copy of Declaration of Mr. Arturo Bustamante.

Respectfully Submitted,

JOHN J. OSKOREP
Reg. No. 41,234

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/743,644	21-Apr-04	RODRIGUEZ	0110-0001

Title: CORDLESS TELEPHONE-TO-SOUND CARD
INTERFACE ADAPTER HAVING A HYBRID
TRANSFORMER CIRCUIT

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Art Unit	Paper Number
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Correspondence Address:

JOHN J. OSKOREP
ONE MAGNIFICENT MILE CENTER
SUITE 1400
980 N. MICHIGAN AVENUE
CHICAGO, IL. 60611

Miled n.k.
~~RECEIVED~~
MAY 24 2004
LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the
Petition for Retroactive License under 37 CFR 5.25.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

John J. Oskorep
One Magnificent Mile Center
Suite 1400
980 N. Michigan Avenue
Chicago IL 60611

In re: Rodriguez : DECISION ON REQUEST
Serial No.: 10/743,644 : UNDER 37 CFR 5.25
Filing date: December 22, 2003
Docket No: 0110-0001

Title: **CORDLESS TELEPHONE-TO-SOUND CARD INTERFACE ADAPTER
HAVING A HYBRID TRANSFORMER CIRCUIT**

This is a decision on the petition filed on April 21, 2004 for retroactive foreign filing license.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
 - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
 - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
 - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

The petition is denied since none of the requirements of 37 CFR 5.25 (1) (2) and (3)(ii-iii) have been met.

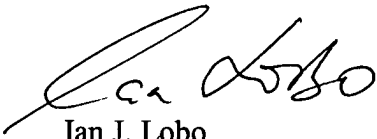
First, under 37 CFR 5.25 (1)(2) a listing, of each of the foreign countries in which the unlicensed patent application was filed and the dates on which the material was filed in each country is required.

Second, the petition is denied under 37 CFR 5.25 (3)(ii-iii). In order to secure a retroactive foreign filing license, applicant or petitioners must provide evidence that the subject matter was filed abroad through error and without deceptive intent. The instant petition fails in that it lacks sufficient evidence to conclude that the material was filed abroad through error and

without deceptive intent. Sufficient evidence would include a verified statement or statements by the person or persons (in the instant case the British counsel) who had knowledge and made the actual decision to file. Such a statement should reference the error of not obtaining a foreign license. Statements of error must be supported by fact. They should not be merely conclusionary but must include how and why the error occurred.

Finally, the instant petition does not include a copy of the application, in English, that was filed abroad.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).

A handwritten signature in black ink, appearing to read 'Ian J. Lobo', is positioned above the printed name.

Ian J. Lobo
Patent Examiner
(703) 306-4161

Instituto
de la Propiedad
Industrial



- ☒ Solicitud de Patente
☐ Solicitud de Registro de Modelo de Utilidad
☐ Solicitud de Registro de Diseño Industrial
- ☐ Modelo Industrial ☐ Diseño Industrial

Uso exclusivo Delegaciones y
Subdelegaciones de la Secretaría de
Economía y Oficinas Regionales de
IMPI

Seño

Folio de entrada

Fecha y hora de recepción

INSTITUTO MEXICANO DE
LA PROPIEDAD INDUSTRIAL

Dirección Divisinal de Patentes

Expediente: PR/a/2883/885992
 Fecha: 2/JUL/2003 Hora: 11:43
 Folio: PR/E/2883/825784



Antes de llenar la forma leer las consideraciones generales al reverso

DATOS DEL (DE LOS) SOLICITANTE(S)

El solicitante es el inventor ☒

El solicitante es el causahabiente ☐

1) Nombre (s): L. Ricardo Rodríguez de la Garza

2) Nacionalidad (es): Mexicana

3) Domicilio: calle, número, colonia y código postal: 10 Sterling Circle Apt 102, Wheaton Illinois, 60187 E.U.A.

Población, Estado y País: Wheaton Illinois, Estados Unidos de América.

4) Teléfono (clave): (630) 682 8131

5) Fax (clave):

DATOS DEL (DE LOS) INVENTOR(ES)

6) Nombre (s): L. Ricardo Rodríguez de la Garza

7) Nacionalidad (es): Mexicana

8) Domicilio: calle, número, colonia y código postal: 10 Sterling Circle Apt 102, Wheaton Illinois, 60187 E.U.A.

Población, Estado y País: Wheaton Illinois, Estados Unidos de América

9) Teléfono (clave): (630) 6828131

10) Fax (clave):

DATOS DEL (DE LOS) APODERADO(S)

11) Nombre (s): Arturo Bustamante Lora, Rafael J. Mendoza Ruiz, Fernando Rodríguez de la Garza, Santa Esther Jafre Villalón

12) R.G.P. ☒

13) Domicilio: calle, número, colonia y código postal: Montes Urales 470 Primer Piso Col. Lomas de Chapultepec C.P. 11000

Población, Estado y País: México Distrito Federal, México

14) Teléfono (clave): 55408063

15) Fax (clave):

16) Personas Autorizadas para oír y recibir notificaciones:

17) Denominación o Título de la Invención:

Adaptador de Telefonía Internet Inalámbrico

18) Fecha de divulgación previa

19) Clasificación Internacional

uso exclusivo del IMPI

Día Mes Año

20) Divisinal de la solicitud

21) Fecha de presentación

Día Mes Año

Número

Figura jurídica

Fecha de presentación

22) Prioridad Reclamada:

País

Día

Mes

Año

No. de serie

2) Nacionalidad (es): Mexicana

3) Domicilio, calle, número, colonia y código postal: 10 Starling Circle Apt 102, Wheaton Illinois, 60187 E.U.A.

Población, Estado y País: Wheaton Illinois, Estados Unidos de América.

4) Teléfono (clave): (630) 682 8131

5) Fax (clave):

DATOS DEL (DE LOS) INVENTOR(ES)

6) Nombre (s): L. Ricardo Rodríguez de la Garza

7) Nacionalidad (es): Mexicana

8) Domicilio, calle, número, colonia y código postal: 10 Starling Circle Apt 102, Wheaton Illinois, 60187 E.U.A.

Población, Estado y País: Wheaton Illinois, Estados Unidos de América

9) Teléfono (clave): (630) 6828131

10) Fax (clave):

DATOS DEL (DE LOS) APODERADO(S)

11) Nombre (s): Arturo Bustamante Loranca, Rafael J. Mendez Ruiz, Fernando Rodríguez de la Garza, ✓ 12) R G P:
Samia Esther Jaspe Villalón

13) Domicilio, calle, número, colonia y código postal: Montes Urales 470 Primer Piso Col. Lomas de Chapultepec C.P. 11000

Población, Estado y País: México Distrito Federal, México

14) Teléfono (clave): 55408063

15) Fax (clave):

16) Personas Autorizadas para oír y recibir notificaciones:

17) Denominación o Título de la invención:

Adaptador de Telefonía Internet Instantáneo

18) Fecha de divulgación previa

Día Mes Año

19) Clasificación Internacional

uso exclusivo del IMPI

20) Divisiva de la solicitud

Número

Figura jurídica

Fecha de presentación
Día Mes Año

21) Fecha de presentación

Día Mes Año

22) Prioridad Reclamada:

País

No. de serie

Lista de verificación (uso interno)

No. Hojas

1	2
3	4
5	6
7	8
9	10

Comprobante de pago de la tarifa
Descripción y reivindicación (es) de la invención
Dibujo (s) en su caso
Resumen de la descripción de la invención
Documento que acredite la personalidad del apoderado

No. Hojas

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15

Documento de cesión de derechos
Constancia de depósito de material biológico
Documento (s) comprobatorio(s) de divulgación previa
Documento (s) de prioridad
Traducción
TOTAL DE HOJAS

Observaciones:

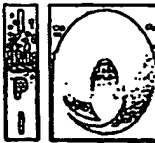
Bajo protesta de decir verdad, manifiesto que los datos asentados en esta solicitud son ciertos.

ARTURO BUSTAMANTE LORANCA
Nombre y firma del solicitante o su apoderado

MEXICO, D.F. a 2 de Julio de 2003
Lugar y fecha

IMPLM-001

Instituto
Mexicano
de la Propiedad
Industrial



México, D.F., 2 de Julio del 2003

Solicitud No. _____ Inicial ()

Bajo protesta de decir la verdad declaro con respecto al beneficio en las disposiciones Generales cláusula Cuarta (fracción III) de la tarifa por los servicios que presta es H. Instituto, de encontrarme en el supuesto abajo señalado, por lo que solicito el 50% de descuento de la tarifa establecida para el Artículo 1 A.

Hago la presente declaración en cumplimiento de dicho artículo, según el acuerdo por el que se da a conocer la tarifa por los Servicios que presenta el Instituto Mexicano de la Propiedad Industrial, publicado en el Diario Oficial de la Fracción con fecha 15 de marzo de 2002.

Marque con una (X)

Inventos o persona física ☒

Micro o pequeña industrial ()

Instituciones de educación superior públicas o privadas ()

Instituciones de Investigación Científica y Tecnológica del Sector Público ()

ATENTAMENTE,

Nombre: Arturo Bustamante Lorenzana

Firma: Arturo BL



SOLICITANTE ()

APODERADO (X)

PODER

SRES.: ARTURO BUSTAMANTE LORANCA, RAFAEL J. MENDOZA RUIZ,
FERNANDO RODRIGUEZ DE LA GARZA, SAMIA ESTHER JALIFE VILLALON

Caballeros:

Por medio de la presente confiero a ustedes poder general para pleitos y cobranzas y para actos de administración, para ejercerlo conjunta o separadamente, en términos del primero y segundo párrafos del artículo dos mil quinientos cincuenta y cuatro del Código Civil Federal, con todos los poderes especiales y generales que requieran de cláusula especial de conformidad con el artículo dos mil quinientos ochenta y siete del mismo ordenamiento y de sus correlativos a los artículos dos mil quinientos cincuenta y cuatro y dos mil quinientos ochenta y siete que sean aplicables en todos los Estados de la República Mexicana.

Sin limitar la generalidad de lo anterior, el poder antes mencionado podrá ser ejercitado ante toda clase de personas físicas y autoridades, ya sean federales, estatales, o municipales; organismos descentralizados o de participación estatal mayoritaria, así como ante autoridades administrativas, militares, laborales y judiciales. Sin limitar la generalidad de lo anterior, este poder otorga facultades específicas a mis representantes arriba descritos, para presentar y llevar todos los procedimientos necesarios para la obtención, registro y publicación de mis patentes, modelos de utilidad, marcas, nombres comerciales, avisos comerciales, diseños y modelos industriales, derechos de autor y reservas; la inscripción de cesiones de derechos en mi favor; renovaciones normales y especiales de mis registros; comprobación de uso o explotación de mis marcas, patentes y otros de derechos de propiedad industrial e intelectual; exámenes de novedad; pago de impuestos y derechos.

Este poder es otorgado el 13 de Junio de 2003, en la Ciudad de México, D.F.



(firma ilegible)

Por:

L. Ricardo Rodríguez de la Garza
10 Sterling Circle, Apt 102

Blanca E. Hefferan de Rodríguez

(firma ilegible)
(Testigo)

Nombre: Blanca E. Hefferan de Rodríguez
Domicilio: Av. México No. 1256, Casa 120
Col. Santa Teresa,
Del. Magdalena Contreras,
México, D.F. 10710



(firma ilegible)
(Testigo)

Nombre: Mónica Rodríguez Hefferan
Domicilio: Av. México No. 1256, Casa 120
Col. Santa Teresa,
Del. Magdalena Contreras,
México, D.F. 10710

Nota: Este poder debe contener el nombre completo y domicilio completo de los testigos.